



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,745	08/18/2000	Robert A. Rosania	9567-3	7327

570 7590 04/24/2003

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 04/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,745

Applicant(s)

ROSANIA ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. *Claims 6-8, 10, 12 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited "at least one---- and mixtures thereof" per claim 6 constitutes indefinite subject matter as per said phrase engendering a redundancy.*

B) *The recited "derivatives thereof" per claim 6 constitutes indefinite subject matter as per the metes and bounds of such compounds engender an indeterminacy in scope.*

C) *The recited "molecular weight" per claim 10 constitutes indefinite subject matter as per it not being readily ascertainable as to the type of molecular weight intended, i.e. "weight average" or "number average", the two being substantially different as provided under the guise of Ex parte Simpson(61 USPQ2d 1009).*

D) *The recited "dimethylaminoethylmetacrylate" per claims 12 and 19 engender an inconsistency with art recognized subject matter. Use of "dimethylaminoethylmethacrylate" is proper and is suggested.*

Claim Rejections - 35 USC § 102

3. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1713

4. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. *Claims 1, 2, 6-9, 11-13, 15 and 16 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haldankar(U.S.5,998,535) as per reasons of record per paper no. 10, 09/11/02, paragraph no. 9. Moreover, Haldankar exemplifies a paint formulation defined as containing a black pigment(Raven 5000) @ 17.0 g, Dispersant resin(hydroxy-functional polymer) @ 65.4 g, methylamylketone @ 17.6 g and steel balls @ 400 g. Therefore, this Run anticipates the instantly claimed invention with the understanding that one of ordinary skill in the art would have readily envisioned the use of the recited components in contents falling within the scope of the claims following the guidelines of Haldankar @ cols. 3-7 and with the understanding that "about" per the instant claims, permits latitude above and beyond the scope of the claims, said term being relative and not absolute.*

Claim Rejections - 35 USC § 103

6. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. *Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haldankar(U.S. 5,998,535).*

Art Unit: 1713

The disclosure of Haldankar for what it teaches and as applied to claims 1, 2, 6-9, 11-13, 15 and 16 is as stated in paragraph 5 supra. Further, the disclosure of Haldankar differs basically from the claimed invention as per the non-specifically defined hydroxy-functional acrylic copolymer(claim 14) and the specific ketone(claim 14), as claimed. However, the use of any commercially available hydroxy-functional acrylic copolymer in lieu of the disclosed hydroxy-functional acrylic copolymer of Haldankar would have been obvious to the skilled artisan and with a reasonable expectation of success. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record. Further, the recited "ketones" per Haldankar are generic to and necessarily include any ketone, including the claimed ketones, as operable within the scope of patentee's invention and with a reasonable expectation of success. Moreover the use of ketone compounds, homologous to the exemplified methylamylketone per Haldankar, would have been obvious to the skilled artisan and with a reasonable expectation of success, homologues being compounds differing only by a methylene linkage. This rejection of claims 10 and 14 under 35 USC 103(a) is herein being made with the understanding that the 102 portion of the 102(e)/103 rejection, made in the previous Office Action(paper no. 10, 09/11/02, paragraph no. 9), is not being maintained.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. *Claims 1-19 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oi et al(U.S. 5,788,914, as applied to claims 1, 2, 5-7, 13 and 16), Hattori et al(U.S. 6,051,361, as applied to claims 1, 2 and 5-19) or Akiyama et al(U.S. 6,136,425, as applied to claims 1-19) as per reasons of record per the previous Office Action per paper no. 10, 09/11/02, paragraph no. 12. Each of Oi et al, Hattori et al and Akiyama et al anticipate the instantly claimed invention with the understanding that the compositional formulations of each of*

Art Unit: 1713

patentees overlap in scope with the compositional formulation per the instantly claimed invention, in both content and character and with the understanding that "about" per the instantly claimed invention permits latitude above and beyond the scope of the claims, said term being relative and not absolute.

Response to Arguments

9. *Applicant's arguments filed December 17, 2002 have been fully considered but they are not persuasive.*

Relative to the 112, 2nd paragraph issues---While Counsel, in a good faith effort, attempted to remedy the 112, 2nd paragraph issues raised in a previous Office Action, some issues remain and new issues were created and are as set forth supra. Counsel is invited to review any basic polymer chemistry textbook which clearly supports the Examiner's position that "weight average" and "number average" molecular weights are, in fact, different.

Relative to Haldankar---The crux of Counsel's arguments appears to hinge on the pigments of Haldankar not being NIR absorbing agents. To this end, Counsel, is cordially invited to review prior art of record, viz., Hattori et al @ col. 16, lines 28-31, Akiyama et al @ col. 17, lines 23-24 and col. 2, lines 18-20 of U. S. 5,553,714 to Cushman et al(cited on the attached PTO FORM 892) which clearly supports the Examiner's position, i.e., pigments such as carbon black, iron oxide, graphite, etc. are conventionally known as near infrared absorbers.

Relative to Oi et al---Counsel argues that the content of solvent to be included in the formulation is not taught nor suggested and to this end, Counsel is cordially directed to at least Run 14 for solvent content falling within the scope of the claims. There is absolutely nothing viable on this record diffusing this issue.

Relative to Hattori et al---The crux of Counsel's arguments appears to hinge on Hattori not disclosing the amounts of the compositional components as recited in the instant claims. To this end, Counsel is cordially invited to review Hattori et al, in its entirety(examples

inclusive) so as to diffuse this position. It is urged and maintained that the compositional components, in both content and character, of Hattori et al overlap in scope with the claimed compositional components.

Relative to Akiyama et al---The crux of Counsel's arguments appears to hinge on the utility of the disclosed solvents being for the preparation of other than the imaging layer. To this end, Counsel is cordially directed to col. 27, lines 30-39 and col. 29, lines 31-48, wherein this disclosure translates to each layer, including the imaging layer, being dissolved in a solvent. Moreover, Counsel is cordially directed to review the coating solutions for the imaging layer per cols. 32-33.

Conclusion

10. The prior art to Nagashima et al(JP 407267683A) is cited as of interest in teaching infrared light absorber-containing coating compositions, used for coating a transparent base, comprising at least a NIR absorbing agent, an acrylic resin, an organic solvent and other conventional additives. Nagashima et al may be used in the future to support a rejection under 35 USC 102(b)/103(a) over the instantly claimed invention. However, a rejection of this nature is not being made at this time since the prior art rejections made supra appear to still be valid. The prior art to Koshida et al(JP 404320466 A) is likewise cited as of interest in teaching an ink composition containing a binder resin, a near-infrared absorber and a cyclohexanone solvent and is considered merely cumulative to the prior art supra. The prior art to Cushman et al(U.S. 5,553,714) is cited for teaching that near infrared absorbing compounds include carbon black and iron oxide. The remainder of the prior art is cited as of being illustrative of the general state of the art.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the

Art Unit: 1713

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J M Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
April 15, 2003